

REMARKS

In the present Office Action, the Examiner rejected Claims 1-4 and withdrew Claims 15-19 from consideration. In the present Communication, Applicants have amended Claim 1, cancelled Claims 2-4, and added new Claims 22-23. As such, Claims 1 and 22-23 are currently pending.

The Examiner's rejections are as follows:

- I. Claims 1-4 were rejected under 35 U.S.C. 112, second paragraph, as allegedly indefinite;
- II. Claim 1 was rejected under 35 U.S.C. 102(b) as allegedly anticipated by Boehringer Mannheim (1997 Biochemicals Catalog, page 95);
- III. Claim 1 was rejected under 35 U.S.C. 102(b) as allegedly anticipated by Sigma-Aldrich Techware Laboratory Equipment and Supplies (1995-1996, page 213);
- IV. Claim 1 was rejected under 35 U.S.C. 102(b) as allegedly anticipated by Shuber (U.S. Pat. 5,834,181);
- V. Claims 2-4 were rejected under 35 U.S.C. 103(a) as allegedly obvious over Shuber and Fors et al. (Pharmacogenomics, vol. 1, no. 2, pages 219-229, 2000); and
- VI. Claims 2-4 were rejected under 35 U.S.C. 103(a) as allegedly obvious over Shuber and Fors et al. (U.S. Pat. Pub. 2003/0152942A1).

Prior to addressing the rejections, Applicants note that, for business reasons and to further the prosecution of the present application, without acquiescing to any of the Examiner's rejections, Claim 1 has been amended. In particular, Claim 1 has been amended to recite components of the detection assay, including first and second oligonucleotides configured to form an invasive cleavage structure with a target sequence, wherein the first oligonucleotide comprises a 5' portion and a 3' portion, wherein said 3' portion is configured to hybridize to the target sequence, wherein the 5' portion is configured to not hybridize to the target sequence, and wherein the second oligonucleotide comprises a 5' portion and a 3' portion, wherein the 5' portion is configured to hybridize to the target sequence, and wherein the 3' portion is configured to not hybridize to the target sequence, and wherein the second oligonucleotide comprises SEQ ID NO:85.

I. Indefiniteness Rejection

The Examiner has rejected Claims 1-4 under 35 U.S.C., 112 second paragraph, as allegedly indefinite. In particular, the Examiner alleges that is unclear how a kit can compose an assay and that a kit should be composed of the components of an assay (Office Action, pages 3-4). Applicants disagree with this rejection. Nonetheless, as noted above, Claim 1 has been amended to recite components of the detection assay, specifically, first and second oligonucleotides. As such, Applicants submit that this rejection should be withdrawn.

II-IV. Novelty Rejections

The Examiner rejected Claim 1 under 35 U.S.C. 102(b) with three different references: Boehringer Mannheim (1997 Biochemicals Catalog, page 95), Sigma-Aldrich Techware Laboratory Equipment and Supplies (1995-1996, page 213), and Shuber (U.S. Pat. 5,834,181). Applicants disagree with these rejections. Nonetheless, as noted above, Claim 1 has been amended to recite first and second oligonucleotides that hybridize with a target sequence to form a cleavage structure. Claim 1 further specifies that the second oligonucleotide comprises SEQ ID NO:85, which is not taught in the cited references. As such, these three rejections should be withdrawn.

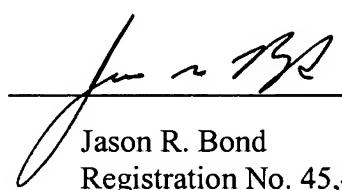
V-VI. Obviousness Rejections

The Examiner rejected Claims 2-4 under 35 U.S.C. 103(a) with two different combination of references. In particular, the Examiner rejected Claims 2-4 as allegedly obvious over Shuber in view of Fors et al. (Pharmacogenomics, vol. 1, no. 2, pages 219-229, 2000), and also rejected Claims 2-4 as allegedly obvious over Shuber in view of Fors et al. (U.S. Pat. Pub. 2003/0152942A1). Applicants disagree with these rejections. Nonetheless, as noted above, Claims 2-4 have been cancelled, and the limitations of Claims 2-4 now appear in Claim 1. Claim 1 also specifies a particular second oligonucleotide (SEQ ID NO:85). None of the references cited by the Examiner, alone or in combination, teach a second oligonucleotide comprising SEQ ID NO:85. As such, Applicants submit that no *prima facie* case of obviousness could be made against Claim 1 as amended. Therefore, both of these rejections should be withdrawn.

CONCLUSION

For the reasons set forth above, it is respectfully submitted that Applicants' claims should be passed to allowance. If the Examiner wishes to discuss this application, Applicants encourage the Examiner to call the undersigned at 608-218-6900 at the Examiner's convenience.

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